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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/667,162	09/17/2003	Eric Fresnel	6758-03	8451

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Marina F. Cunningham
McCormick, Paulding & Huber LLP
CityPlace II
185 Asylum Street
Hartford, CT 06103

EXAMINER	
GERRITY, STEPHEN FRANCIS	
ART UNIT	PAPER NUMBER

3721

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,162

Applicant(s)

FRESNEL, ERIC

Examiner

Stephen F. Gerrity

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/2/04 and 5/13/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Substitute Specification

1. Receipt is acknowledged of a substitute specification, filed 17 September 2004, which has been placed of record and entered in the file.

Response to Preliminary Amendment

2. Receipt is acknowledged of a preliminary amendment, filed 17 September 2004, which has been placed of record and entered in the file.

Information Disclosure Statement

3. Receipt is acknowledged of Information Disclosure Statements, filed 2 February 2004 and 13 May 2004, which have been placed of record in the file. An initialed, signed and dated copy of each of the PTO-1449 forms is attached to this Office action.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claim 14: "wherein the radiant chimney is of variable wall thickness and/or cross-section in the event of there being significantly different shrinkage percentages between bottom and top zones of the sleeve

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to be shrunk onto the article" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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Claim Rejections - 35 USC § 101 and 112

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the subject matter is directed to neither a "machine" nor a "process". Claim 10 recites "A heat-shrink machine for implementing a method according to claim 1" as well as "a controller governing the parameters of temperature, travel speed of the support and time during the sequences of operations of the method". These recitations embrace or overlap two different statutory classes of invention, namely a "machine" and "process", and thus the claims fail to conform with 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

Claims 10-21 are indefinite because claim 10 recites "A heat-shrink machine for implementing a method according to claim 1" as well as "a controller governing the parameters of

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temperature, travel speed of the support and time during the sequences of operations of the method" which makes claims 10-21 ambiguous because it is unclear if the subject matter is directed to a machine or a method. *Ex parte Lyell*, 17 USPQ2d 1548 (BPAI 1990). See MPEP § 2173.05(p)(II).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1, line 2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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Claim 2, lines 1 and 2, the recitation "travel speed of the support" lacks proper antecedent basis and renders the claim vague and indefinite because claim 1 does not particularly point out that the support recited in claim 1 is made use of in step (c) of the claim.

Claim 6, line 2, the language "the desired temperature" lacks proper antecedent basis. It is suggested that such be changed to --a desired temperature--.

Claim 7, the recitations "while transferring the article into the pre-heater chamber" and "while causing said article to pass through the shrinkage chamber" each render the claimed subject matter vague and indefinite. Claim 1 does not positively or particularly point out that the moving support in fact is used in the steps of "transferring the article..." or "passing the article...".

It is respectfully requested that each of claims 1-9 be carefully reviewed and amended in order ensure that the claims particularly point out that the moving support recited in claim 1 is also used to transfer the article and pass the article. The subject matter of dependent claims 2-9 is rendered vague and indefinite in a number of instances because applicant has not

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particularly pointed out in claim 1 that the moving support is used to transfer the article and pass the article.

Claim 12, line 2, the use of the language "and possibly also" renders the claim vague and indefinite because it is unclear as to the scope of the claim.

These and any other informalities should be corrected so that the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -(

b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Abe et al. (JP 4-311434).

Regarding claim 1, the Abe et al. reference discloses a method of heat-shrinking sleeves (see translated abstract) made from a film of heat-shrunk plastics material (see translated abstract) and engaged individually on articles such as bottles, the method comprising the following successive steps: a) placing

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a single article (3) on a moving support (2), a sleeve (see translated abstract) being engaged on said article(3); b) transferring the article (3) together with its sleeve into a pre-heater chamber (A) at a controlled temperature (whatever is the temperature in the chamber, it is a controlled temperature), and maintaining said article (3) in said chamber for a predetermined duration (whatever is the duration in the chamber, it is a predetermined duration) so as to prepare the film constituting the sleeve in optimum manner for subsequently shrinking the sleeve onto the article; c) passing the article together with its sleeve at a controlled speed (whatever is the speed in the chamber, it is a controlled speed) through a shrinkage chamber (B) at controlled temperature (whatever is the temperature in the chamber, it is a controlled temperature), the shrinkage chamber being adjacent to the pre-heater chamber (as seen in the figures), thereby causing the sleeve to shrink onto the article; and d) removing the article coated in its shrunk-on sleeve from the support (the article leaves chamber (B) and is inherently removed from the support (2)).

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12. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Fresnel (EP 0058602).

Regarding claim 1, the Fresnel reference discloses a method of heat-shrinking sleeves (see translated abstract) made from a film of heat-shrunk plastics material (see translated abstract) and engaged individually on articles such as bottles, the method comprising the following successive steps: a) placing a single article (4) on a moving support (3), a sleeve (see translated abstract) being engaged on said article(4); b) transferring the article (4) together with its sleeve into a pre-heater chamber (A) at a controlled temperature (whatever is the temperature in the chamber, it is a controlled temperature), and maintaining said article in said chamber for a predetermined duration (whatever is the duration in the chamber, it is a predetermined duration) so as to prepare the film constituting the sleeve in optimum manner for subsequently shrinking the sleeve onto the article; c) passing the article together with its sleeve at a controlled speed (whatever is the speed in the chamber, it is a controlled speed) through a shrinkage chamber (B, C) at controlled temperature (whatever is the temperature in the chamber, it is a controlled temperature), the shrinkage chamber being adjacent to the pre-heater chamber (as seen in the

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figures), thereby causing the sleeve to shrink onto the article; and d) removing the article coated in its shrunk-on sleeve from the support (the article leaves chamber (B, C) and is inherently removed from the support (3)).

Regarding claim 4, the walls of the pre-heater chamber (A) in the Fresnel apparatus will become heated and thus inherently heat the article (4) by the effect of radiation.

Regarding claims 5 and 6, as seen in the figures and as discussed in the translated abstract, in the Fresnel apparatus, the temperature that exists inside the shrinkage chamber (B) is obtained by blowing in hot air (blower 7) and by diffusing the blown-in air (inherently done by the circulation of the air within the chamber), and the air blown into the shrinkage chamber is also made use of periodically for maintaining the desired temperature inside the pre-heater chamber (see the translated abstract).

Allowable Subject Matter

13. Claims 2, 3, and 7-21 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 101 and/or 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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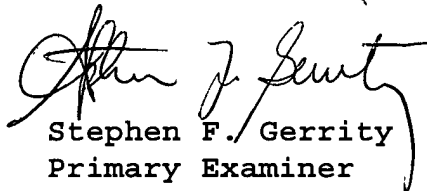
Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached form (PTO-892) are cited to show to methods and machines used in heat shrinking of sleeves. All are cited as being of interest and to show the state of the prior art.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gerrity. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, may be contacted. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stephen F. Gerrity
Primary Examiner
Art Unit 3721

Examiner's Telephone Number: 703-308-1279
Examiner's Work Schedule: Monday-Friday from 5:30 - 2:00
Supervisor's Telephone Number: 703-308-2187
Facsimile Telephone Number: 703-872-9306
Receptionist Telephone Number: 703-308-1148
1 October 2004